

### **REMARKS**

Claims 2, 3, 5, 10-12, 17-19, 25 and 27-34 are currently under consideration. Claims 10, 19, 30 and 31 are amended to address points raised in the outstanding Office Action and clarified at the personal interview held May 5, 2005. The amendments are fully supported in the specification. For example, support for the recitation of "blood, urine or seminal fluid" can be found on page 10, lines 28-29; and support for the recitation concerning the content of the claimed nucleic acid molecule in a patient having prostate cancer can be found on page 17, lines 1-5. Claims 6-8 and 13-16 have been withdrawn from consideration. In addition to the previously cancelled claims, claims 20-24, 26, and 35-40 have been cancelled, without prejudice or disclaimer.

Applicants acknowledge the indication in the Office Action of February 9, 2005 that claims 2, 3, 5, 17, 18 and 27-29 are allowed.

Applicants gratefully thank the Examiner and her supervisor for the extended and very useful personal interview concerning issues in the above-referenced application. The discussion is accurately set forth on the Examiner Summary Record form provided to Applicant. The amendments made herein take into account that discussion. In view of that discussion and the indications in the outstanding Office Action, the instant claims should be allowable.

The Examiners urged that the term "abnormally high content" is indefinite, and suggested during the interview the language as presented in the amended claims. Although disagreeing that the term at issue is indefinite, for the reasons of record, Applicants have amended the claims in the interest of expediting prosecution. The amendments do not narrow the scope of the claims.

The Examiners explained their concerns regarding a "tissue or fluid" sample (in claims directed to a detection method). While not agreeing with the Examiners' position, for reasons of record, in the interest of expediting prosecution claims 10, 19, 30 and 31 have been amended to recite that the samples may be "prostate tissue or blood, urine or seminal fluid." Applicants reserve the right to pursue subject matter given up by the amendment in a continuation application.

Claims 20, 21, 35 and 36 were discussed during the interview. The Examiners alleged that the recitation in these claims of a nucleic acid which "hybridizes specifically"

to another nucleic acid lacks written description and/or lack enablement. Applicants disagree, for reasons that are of record. It is Applicants' position that the term would be well understood by one skilled in the art in light of the specification. Nevertheless, in the interest of expediting prosecution, independent claims 20, 21, 35 and 36 and claims dependent thereon have been cancelled. Applicant reserve the right to pursue the cancelled subject matter in a continuation application. It does not appear that claim 18 is similarly situated.

With regard to the rejections over alleged prior art:

(1) Applicants disagree that the random hexamer sequences in the Boehringer Mannheim Biochemicals catalog anticipate claims 21 and 35, for reasons of record. However, the rejection over that reference is rendered moot by the cancellation of claims 21 and 35.

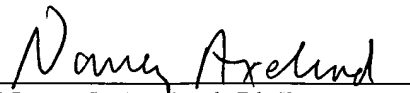
(2) The rejection of claims over WO98/21328-A2 is unwarranted, for reasons of record. It is noted that the reference was removed by virtue of the Declaration under 37 CFR 1.131 filed with the Reply of November 5, 2004. In light of an understanding arrived at during the interview, it is clear than the Examiner was in agreement that the Declaration was merely redacted and not redated.

In view of the preceding arguments and amendments, it is believed that the application is in condition for allowance, which action is respectfully requested.

Should any additional fee be deemed due, please charge such fee to our Deposit Account No.22-026, referencing docket number 31978-202420 and advise us accordingly. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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